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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/076,664 | 02/19/2002 | Katsuhiko Tsunehara | ASAM.0040 | 1722 |

7590 06/16/2005
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EXAMINER

APPIAH, CHARLES NANA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2686

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,664

Applicant(s)

TSUNEHARA ET AL.

Examiner

Charles Appiah

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 2-9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 10, 2005 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2-9 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/274,970 (US 2003/0050079). Although the conflicting claims are not identical, they are not patentably distinct from each other because the

limitation of "wherein when the position calculation method control signal entered from the position calculation method controller corresponds to three or more base stations available for position calculation, the position calculation unit performs the position based on trilateration; when the position calculation method control signal corresponds to two base stations available for position calculation, the position calculation unit performs the position calculation by using a two-station-base position calculation unit; and when the position calculation method control signal corresponds to one base station available for position calculation, the position calculation unit performs the position calculation by using a one-station-based position calculation unit" being met by "wherein if PN offset values corresponding to two or more of said plurality of radio station are same, said CPU selects radio stations to be used for position calculation by determining not to use at least one of the radio stations corresponding to said PN offset value for position calculation".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

4. Claim 10 is allowed.
5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 10, the most relevant prior art off record Bergen (6,097,958) teaches equipment for calculating a mobile handset position by using a cellular radio wave (see abstract), comprising: a signal receiver for receiving a cellular radio wave to

generate a reception signal (exchange of signaling between mobile phone communicating with at least primary BTS and one or more secondary BTSes, col. 2, line 66 to col. 3, line 3), a position calculation information generator for generating position calculation information necessary for position calculation by using the reception signal (feature of BSC informing secondary BTSes what sector to make the time measurements, as well as instructing the primary BTS and the secondary BTSes as to the time at which to take the time measurement ..., col. 3, line 61 to col. 4, line 10), a base station selection unit for selecting base stations available for position calculation according to the position calculation information (inherent feature of BSC 12 determining the three most geometrically well-positioned BTSes available to determine the mobile phone's location, col. 3, lines 30-44), an inherent base station number counter for counting the number of base stations selected by the base station selection unit (it is inherent the BSC 12 keeps a count of the BTSes that are selected in order to provide the best data that can be used to determine the location of the mobile phone, col. 3, lines 30-44), a position calculation method controller for generating according to the number of selected base stations a position calculation control signal to control the position calculation method (BSC 12 informing secondary BTSes what sector to make time measurements, as well as instructing the primary BTS and the secondary BTSes as to the time at which to take the time measurement ..., col. 3, line 61 to col. 4, line 10, STS 15 of BSC 12 constructing and providing measurement schedule, col. 4, line 55 to col. 5, line 26), a position calculation unit for calculating, according to the position calculation method specified by the position calculation method control signal, the

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mobile handset position from the position calculation information and the information on the base stations selected by the base station selection unit (BSC 12 using the time measurements made by the BTSes P1, S1, S2, S3 and S4 to determine the location of the mobile phone 16 by applying TDOA techniques to the time measurement data, col. 4, lines 11-54), and a position information application unit for using the mobile handset position to provide a user with information (use of tracking data to predict when a mobile phone may require hard handoff, facilitating the determination of network traffic for planning, network expansions and updates, market studies and providing location information to the mobile phone for future data services, such as computerized directions, col. 2, lines 7-17, and col.6, lines 22-57). Neither Bergen nor any of the prior art of record teach the feature of the position information application unit controlling information to be provided to the user in addition to the mobile handset position according to the number of base stations selected by the base station selection unit in combination.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Drane et al. (6,275,705) discloses a method for finding a position.

Moon (6,405,047) discloses a system for tracking a mobile station's position in a mobile communication system.

Kennedy, Jr. (6,871,077) discloses a system for geo-locating a mobile wireless mobile unit from a single based station.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA


CHARLES APPIAH
PRIMARY EXAMINER